

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the Reissue
Application Serial No: 09/014,518 Group Art Unit: 1615
Applicant: Roderick Thompson Examiner: W. Krynski
Filed: January 28, 1998
For: *JUN 05 1998* U.S. Patent 5,472,790

GROUP 1100

PROTEST - NEW ISSUES RAISED
BY APPLICANT'S PRELIMINARY AMENDMENT

United States Department of Commerce
Patent and Trademark Office
Assistant Secretary and Commissioner of Patents
and Trademarks
Washington, D.C. 20231

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JUN 05 1998

MATRIX CUSTOMER
SERVICE CENTER

Dear Sir:

Protestor hereby submits new grounds for Protest, which are raised by the Preliminary Amendment filed by the Applicant.

These new issues concern the following:

GB 2248 177 A Is Prior Art Under 35 USC 102(A)

UK patent application GB 2 248 177 A (copy enclosed) was published on January 4, 1992 and is prior art under 35 USC § 1-2) a_ as to the newly submitted claims. The Declaration Under 37 § 131 filed to overcome that reference submitted in the application from which the patent issued does not establish that Applicant had previously invented a mat having the thickness ranges disclosed in the UK reference, as required by 37 CFR §1.131.

GB 2 248 177 A discloses the use of a flexible polypropylene sheet as a food cutting and transfer sheet with a disclosed thickness range of 0.8 mm - 2.0 mm (.0315 inches - .079 inches) with a preferred thickness of 1.2 mm (.047 inches).

The Declaration under 37 CFR §131 (copy enclosed) by Roderick Thompson filed in Serial No. 08/259,006 (filed 6-13-94) alleged a reduction to practice of the invention in October of 1991 by testing of polypropylene sheet samples 0.010 and 0.015 inches thick prior to the January 4, 1992 date of publication of the UK patent.

In the first filed patent application U.S. Serial No. 07/994,665 (certified copy attached), the operative range was described as being from .008 to .030 inches thick, with thicknesses in excess of .030 described as not being able to be flexed to transfer food. See page 6 of the specification where it is stated that:

"Although sheet thicknesses in excess of 0.030 inches would not be perforated by cutting, they cannot be flexed to transfer food as hereafter described."

Thus, it is clear that as of the filing date of December 22, 1992, the inventor did not have "possession" of an invention comprised of cutting sheets over 0.030 inches thick.

This is confirmed by the statement in the Preliminary Amendment filed in this reissue application:

"Subsequent to the filing of the original patent application (Serial No. 07/994,665), which disclosed (and claimed) only the range of 0.008 - 0.030 inches, the inventor discovered that sheets having other, somewhat greater thicknesses would also be suitable." (Emphasis added.)

While the Thompson Rule 131 Declaration stated that he conceived of a thickness range of .008 to .060 in June of 1990, that is manifestly false, since it is inconsistent with all the other pertinent facts and statements of record, i.e., the specification of the first application states that thicknesses over 0.030 were inoperative, and Applicant admitted in the Preliminary Amendment that operativeness of thicknesses over 0.030 inches was discovered subsequently. In addition, the second application was identified as a Continuation-In-Part of the first application based on the different thickness ranges described and claimed.

Only samples 0.010 and 0.015 inches thick were apparently tested in October 1991, and thus there was a reduction to practice only of a range of sheet thicknesses of 0.010 to 0.015 inches prior

to the January 4, 1992 publication date of the UK reference.

Thus, under In re Stempel 113 USPQ 77 (CCPA 1957), the Thompson Rule 131 Declaration and other facts indicate that Mr. Thompson cannot establish priority as to that which the reference shows, i.e., a flexible polypropylene cutting sheet of a thickness greater than 0.030 inches (and method of uses thereof).

For this reason, GB 2 248 177 A describing 0.0315 inch thick sheet of polypropylene used as a cutting and transfer sheet is prior art under 35 USC §102(a), and renders obvious new claims 12-15, as expressly describing each limitation including the thickness ranges over 0.030 inches, with the exception of the specific Rockwell hardness of 72 or 72-90, and a specific flexural modulus. As discussed in previous filings, the previously cited Modern Plastics Encyclopedia reference show that polypropylene having these values was commercially available in 1991 and that the claims cover virtually all the then available polypropylene. There has been no criticality shown for these range values, as discussed in previous filings.

Furthermore, claims 1 (Amended) and 6 (Amended) are also rendered obvious, since the upper end of the recited ranges, .030 inches, is only slightly different from the thickness of 0.0315 described in GB 2 248 177 A.

As previously discussed, the new ranges recited in the amended claims 1 and 6 and claims 12-15 cannot be relied on to distinguish over Counter-Maid and GB 2 248 177, as there is no criticality shown or even alleged.

See In re Huang 40 USPQ 2d 1685 (CAFC 1996) quoting In re Allen, 105 USPQ 235, 235 (CCPA 1955) which held claim ranges are not patentable "unless the claimed ranges produce a new and unexpected result which is different in kind and not merely in degree from the results of the prior art."

**GB 2 248 177 A Is Prior Art Under
35 USC 102(b) As to Claims 12-15**

Claims 12 and 13 recite a thickness range of 0.030 to 0.060 inches and claims 14 and 15 recite a thickness range of 0.015 to 0.040 inches. These thickness ranges are unsupported by the original specification, as developed above, which limited the thickness of the cutting sheet of the invention to a maximum of 0.030 inches.

Thus, these claims are not entitled to relate back to the original filing date of December 22, 1992. In re Chu, 36 USPQ 2d 1089 (CAFC 1995), but are entitled only to the filing date of the second application on June 13, 1994.

GB 2 248 177 A was published on January 4, 1992, more than one year prior to June 13, 1994. The '177 patent is thus a statutory bar reference as to claims 12-15 under 35 USC § 102(b). Since that reference clearly discloses a range of thicknesses from 0.0315 to 0.060 inches, these claims are unpatentable over that reference.

Applicant has also admitted that sales of its mats in the range of 0.008 - 0.030 inches thick occurred more than one year prior to June 13, 1994, the filing date of U.S. Serial No. 08/259,006 (see page 9 of Supplemental Reissue Declaration by Inventor). Thus, the only difference with mats sold by the Applicant more than one year before June 13, 1994 is the recited thickness in excess of 0.030 inches. As developed heretofore, such difference in thickness is merely one of degree not kind and cannot

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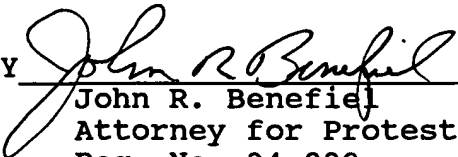
Attorney Docket No. PGV-118

be patentable under 35 USC §103.

Respectfully submitted,

Date: June 4, 1998

BY


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Attorney Docket No. PGV-118

CERTIFICATE OF SERVICE

The signature below certifies that a copy of this Protest - New Issues Raised By Applicant's Preliminary Amendment and all accompanying papers has been served on the patent owner by depositing the documents in an envelope bearing first class postage in an official U.S. Postal Service depository, on the date set forth below, addressed as follows:

Neil F. Martin
Brown, Martin, Haller & McClain
1660 Union Street
San Diego, CA 92101

Date: June 4, 1998

By:


John R. Benefiel